

## **REMARKS**

The Office Action has imposed a Restriction Requirement, under 35 U.S.C. §121 (37 C.F.R. §1.142) with respect to Claims 67, 70, 73-84 and 97-104 as follows:

Group I, Claim 67 drawn to a solid substance, classified in Class 428, subclass 367;

Group II, Claims 70, 73-84 and 97-102, drawn to an electron emissive material, classified in Class 423, Subclass 447.2 and;

Group III, Claims 103-107, drawn to a field emission device, classified in Class 313, Subclass 475.

In support of the Restriction Requirement, the Office Action alleges that the inventions are related as combination and subcombinations. The Office Action has requested that applicants elect one group for continued examination herein.

In order to be responsive to the Restriction Requirement applicants elect, with traverse, to prosecute the invention of Group I, i.e., Claim 67, drawn to a solid substance.

Nevertheless, applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter.

However, applicants hereby traverse the Examiner's requirement for restriction and request reconsideration in view of the following Remarks.

Applicants respectfully request that this Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. 35 U.S.C. §121 provides that the Commissioner may restrict an application when “two or more independent and distinct invention are claimed in a single application.” (Emphasis added). Similarly, 37 C.F.R. §141(a) permits restriction conditioned upon a finding that independent and distinct inventions

are found within one application. Only the statutory requirement that the various groups of claims are distinct has been proffered as the basis for the requirement of restriction. Even assuming, pro arguendo, that the Official Action was correct with respect to distinctiveness, there is absolutely no indication in the Official Action that Groups I, II and III are also independent.

In fact, applicant submits that Groups I, II and III are not independent.

MPEP §802.01 defines independent as follows:

The term “independent” (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect.

Groups I, II and III are not independent. Group I relates to a solid substance comprised by more than one half weight of hollow carbon nanotubes having walls consisting essentially of two layers of carbon atoms i.e., DWNT's, while Group II relates to an-electron emissive material comprised of DWNT's and Group III relates to a field emission device comprised of a cathode comprised of an electron emissive material comprised of DWNTs. Thus, the subject matter in Groups I-III all contain DWNT's, and are thus, clearly interrelated and interdependent, and are not “independent and distinct”.

Thus, because these groups of claims are interdependent, and therefore not independent, the claims which the Office Action has grouped separately are not “independent and distinct” so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

The Office Action also seems to suggest that a prior art search requiring search in more than one classification is sufficient criteria for maintaining a restriction to allegedly different patentable inventions. This of course is in error.

Reliance on the classification of the groups of claims does not establish that the subject matter in the various group are independent and distinct. The classification system has no statutory recognition as evidence of whether inventions are independent or distinct. The classification system is instead an aid in finding and searching for patents.

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of applicant's unitary invention, because the classification system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent an Examiner from basing patentability decisions, as to claims he assigned to one group, on patent references found in the subclass(es) with which he associated another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to

different classifications is “independent and distinct”, as those terms are used in 35 U.S.C. §121, which fact proves that basing restriction requirements on the classification system is improper.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s rights and to serve the public’s interest in the legitimacy of issued patents, applicants respectfully urge the

Examiner not to require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention.

The CCPA has observed:

We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved. (Emphasis added).

In re Kuehl, 456, F.2d 658, 666, 177 USPQ 250, (CCPA 1973).

Furthermore, applicants respectfully request that in view of increased Official Fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the Restriction Requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,



Mark J. Cohen

Registration No. 32,211

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, NY 11530-0299  
(516) 742-4343  
MJC:kd